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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/964,754	09/28/2001	Yoshihiro Itoh	05905.0153	3110

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Finnegan, Henderson, Farabow,  
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1300 I Street, N.W.  
Washington, DC 20005-3315

EXAMINER
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LABAZE, EDWYN

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 09/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/964,754

Applicant(s)

ITOH ET AL.

Examiner

EDWYN LABAZE

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 26-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8112004.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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### **DETAILED ACTION**

1. Receipt is acknowledged of IDS filed on 8/11/2004.
2. Claims 26-43 are presented for examination.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 26-39, 41, and 43 are rejected under 35 U.S.C. 102(e) as being anticipated by Masahiro et al. (JP 2000-056721).

Re claims 26, 32, 37, 39, and 41: Masahiro et al. discloses device and method for outputting condition advertisement and record medium, which includes a first personal database [herein disclosed as advertising information storage means F3 by which the information J30 regarding each customer's purchase history] for registering the user's personal information [such as name, gender, age family structure] sent from the portable

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terminal (paragraphs 0054-0056); means for creating and/or encoding an electronic coupon bar code by presuming the user's tastes according to the user's personal information [from the purchase history information J10, which includes the name of article, the number a price, time, and the like; wherein an advertisement is creating according to two or more patterns stored into the store side which stocked the purchase history of the customer (see paragraph 0057) and wherein the good read by the bar code reader J6 are the advertisement target product (see paragraph 0065)] registered in the personal database, by preparing the electronic coupon [Masahiro et al. discloses an advertisement information, which could be in the form of a coupon, and the barcode for settlement of accounts may be printed thereon] content that suits the user's tastes and by encoding the prepared electronic coupon content (see fig. # 17; paragraph 0112); and means for delivering image data, including the electronic coupon bar code, to the user's portable terminal (paragraphs 0084+), wherein the portable terminal [herein discloses as a simple cellular phone F56] comprises a storage means for storing the delivered image data and a displaying means [through the display F54] for displaying the image data (paragraphs 0073-0087), and wherein an information processing terminal having a bar code reader [Masahiro et al. disclosed the POS terminal is equipped of a register F6 with a bar code reader, which reads the bar code J6] reads, using its bar code reader, the electronic coupon bar code contained in the image data displayed on the display means of the portable terminal, recognizes the electronic coupon content according to the electronic coupon bar code J6 that has been read, performs the necessary processing to provide a service according to the recognized electronic coupon content, and sends new personal information generated by the service to the server so that the new personal

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information is reflected in the electronic coupon content for the next delivery (paragraphs 0064-0073). Masahiro et al. further discloses a first personal database J30, a second personal database J10, means for delivery [through output means F5, which is a combination of the inside-of-a-shop electric-sender wave F55] image data including the membership bar code to the user's portable terminal [the cellular phone F56 as shown in fig. # 12] (paragraphs 0084-0085), means of creating a membership barcode J6 [as shown in fig. # 17, which is an advertising target product created for each customer generated from the purchase history of the customer] (paragraphs 0110+).

Re claims 27, 33, 38, and 43: Masahiro et al. teaches a system and method, wherein the server has a product information database for registering specified information according to a plurality of products, wherein the means for creating the electronic coupon bar code creates an electronic coupon bar code including a user ID code [herein disclosed as specific information J2 regarding the customer] for the user (paragraph 0054), wherein the information processing terminal specifies the user by reading, using its bar code reader, the electronic coupon bar code J6 displayed on the display means F54 of the portable terminal J21, and specifies a product selected by the user by using the bar code reader, and sends information about the user's selected product according to the specified user and product, and wherein the server registers the received information about the user's selected product, and presumes the user's tastes according to a purchase history [which is stored in the database J10] of the user so that said presumption of the user's tastes is reflected in the electronic coupon content for the next delivery (paragraphs 0064+), and wherein the information processing terminal specifies the user according to the electronic coupon bar code displayed on the display means, and

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specifies a product selected by the user by reading, with its bar code reader, the bar code of the product selected by the user, and sends information about the product purchased by the specified user to the server (paragraphs 0065+).

Re claim 28: Masahiro et al. discloses a system and method, comprising of a machine-readable storage medium having a program therein for causing a computer to download data (paragraph 0117).

Re claims 29 and 34: Masahiro et al. teaches a system and method, wherein the server specifies the electronic coupon content for the next delivery on the basis of the user's purchase history in the personal database, so that a better service rate [such as discount price, discount rate] will be provided with regard to products having a high purchase frequency (paragraph 0065+).

Re claims 30, 35: Masahiro et al. discloses a system and method, wherein the server specifies the electronic coupon content for next delivery on the basis of the information, which is registered in the product information database, regarding products for which a seller wants to increase sales, and on the basis of the user's purchase history in the personal database (paragraph 0134).

Re claims 31 and 36: Masahiro et al. teaches a system and method, wherein when the received bar code of the product purchased by the user corresponds to an identification of a previously determined discount product, the server notifies the information processing terminal of an electronic coupon bar code to allow application of the discount to the price of the product purchased by the user (paragraphs 0123-0131).

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Masahiro et al. (JP 2000-056721) in view of Linden et al. (U.S. 6,360,254).

The teachings of Masahiro et al. have been discussed above.

Masahiro et al. fails to teach that the image data is automatically delivered based upon a history of the user's accessed internet web pages and means of delivering information about the specified product via e-mail to the user's portable terminal.

Linden et al. discloses system and method for providing secure URL-based access to private resources, wherein the image data is automatically delivered based upon a history of the user's accessed internet web pages (see fig. # 6; col.10, lines 18-28) and means of delivering information about the specified product via e-mail to the user's portable terminal (see fig. # 10; col.10, lines 42-67).

In view of linden et al.'s teachings, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to employ into the teachings of Masahiro et al. a means of automatically delivering an image data based upon a history of the user's accessed internet web pages and means of delivering information about the specified product via e-mail to the user's portable terminal. Furthermore, such modification would provide a means for setting up promotion conditions suitable for each customer based upon the customer's preferences and purchase history, establishing good

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customer relationship with personal coupons and/or gift certificates and special discount prices/rates based upon purchase frequency. Moreover, such modification would have been an obvious extension as taught by Masahiro et al.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Palmer et al. (U.S. 6,505,773) discloses authenticated electronic coupon issuing and redemption.

Brown et al. (U.S. 6,658,415) teaches monitoring and managing user access to content via a universally accessible database.

Gobburu et al. (U.S. 6,736,322) discloses method and apparatus for acquiring, maintaining, and using information to be communicated in bar code form with a mobile communications device.

Watanabe et al. (US 2002/0032604) teaches electronic coupon issuing system and issuing method.

Kitaura et al. (US 2002/00915690 discloses electronic coupon system.

Shinichiro et al. (JP 2001-351001) teaches electronic coupon management server, electronic coupon system, and electronic coupon distribution method.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EDWYN LABAZE whose telephone number is (571) 272-2395. The examiner can normally be reached on 7:30 AM - 4:00 PM.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

el  
Edwyn Labaze  
Patent Examiner  
Art Unit 2876  
September 15, 2004

A handwritten signature in black ink, appearing to read 'K. Frech', with a stylized, flowing script.

KARL D. FRECH  
PRIMARY EXAMINER